



#12 of Appeal Brief
PATENT
3/31/02
V. H. H. H.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appeal No. _____

Application No.: 09/698,920

Filing Date: October 27, 2000

Applicant: Meredith

Group Art Unit: 3724

Examiner: K. Peterson

Title: GUARD AND CONTROL APPARATUSES
FOR SLIDING COMPOUND MITER SAW

Attorney Docket: 0275A-000168/DVB

RECEIVED
MAR 25 2002
TECHNOLOGY CENTER R3700

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

APPELLANT'S BRIEF

03/22/2002 AWONDAF1 00000015 022548 09698920

01 FC:120 320.00 CH

TABLE OF CONTENTS

	<u>Page</u>
BRIEF ON BEHALF OF APPELLANT	1
I. REAL PARTY IN INTEREST	1
II. RELATED APPEALS AND INTERFERENCES.....	1
III. STATUS OF THE CLAIMS	1
IV. STATUS OF AMENDMENTS	1
V. SUMMARY OF THE INVENTION.....	2
IV. ISSUES	3
1. Whether the combination of Kumasaka et al (4799416) and Cotton et al (4892022) establish a prima facie case of obviousness under 35 U.S.C. § 103(a), with respect to claims 37-52	3
VII. GROUPING OF CLAIMS	3
VIII. ARGUMENTS	3
A. The Combination of Kumasaka et al (4799416) and Cotton et al (4892022) Do Not Render Obvious The Invention of Claims 37-52.....	3
APPENDIX	7

BRIEF ON BEHALF OF APPELLANT

This is an appeal from the action of the Examiner dated October 15, 2001, finally rejecting claims 37-52. Copies of the claims appealed are attached as an appendix.

I. REAL PARTY IN INTEREST

The real party in interest in the present application is Black & Decker Inc. (Assignee).

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 37-58 are pending. Claims 37-52 stand finally rejected. Claims 53-58 were properly submitted with the response filed August 8, 2001 and depend ultimately from one of the independent claims 37 or 45. However, the Examiner has not expressly addressed claims 53-58 in the last Office Action, although they appear to be addressed in the rejection under 35 U.S.C. § 103.

IV. STATUS OF AMENDMENTS

Claims 53-58 apparently have been entered, although they have not been expressly addressed. The amendments to claims 37 and 45 have been entered in this application.

V. SUMMARY OF THE INVENTION

The present invention is directed to a cutting device (item 10; Fig. 1; page 7, lines 10-23) for performing cutting operations on a workpiece (item 13; Fig. 4; Page 7, lines 17-19). The cutting device (10) includes a base (item 12; Fig. 1; page 7, lines 12-17) adapted to receive the workpiece (13). A support (item 32; Fig. 1; Page 8, lines 10-14) is attached to the base (12). A drive assembly (item 36; Figs. 1-4; page 8, lines 12-20) is pivotably attached to the support (32) and includes a motor (item 22; Figs. 1-3; page 7, line 15) having an arbor shaft (item 44; Fig. 8; page 8, lines 22-24) rotatable about an arbor axis (item 45; Figs. 5-10; page 8, lines 22-24). A cutting tool (item 18; Fig. 1; page 7, lines 12-17) is attached to the arbor shaft (44). A fixed guard (item 40; Fig. 1; page 8, lines 21-22) is fixedly attached to the drive assembly and is pivotable with the drive assembly (36). The fixed guard (40) covers a first portion of the cutting tool (18). A movable guard (item 42; Fig. 1; page 8, lines 21-22) is pivotably attached to the drive assembly (36) for pivotal movement about the arbor axis (45). The movable guard (42) is movable between a closed position (Figs. 1, 10a) covering a second portion of the cutting tool (18) and an open position (Figs. 10b, 10c, 10d) exposing the second portion of the cutting tool (18). A separate arbor cover (item 66, Figs. 1, 11, 12, 13a, 13b, 14a, 14b; Page 12, lines 11-21) is pivotably secured to the fixed guard (40), and is pivotable about pivot fastener 67 between a first position Figs. 1, 11, 13a covering the arbor shaft (44) and a second position (Fig. 13b) completely uncovering the arbor shaft (44). A torsional coil spring (item 70, Fig. 6; page 10, lines 18-24) biases the movable guard (42) into the closed position(Fig. 1).

The arbor shaft cover (66) substantially prevents or minimizes any tendency of the arbor shaft nut, screw or other blade-securing fastener (item 64; Figs. 1, 11; page 12,

lines 15-21) to work loose on, or free of, the arbor shaft (44). Such arbor cover (66) can be pivoted out of the way to allow blade removal or blade changing by way of a releasable cover retaining fastener (69) at one end of the pivotal cover (66).

VI. ISSUES

1. Whether the combination of Kumasaka et al (4799416) and Cotton et al (4892022) establish a prima facie case of obviousness under 35 U.S.C. § 103(a), with respect to claims 37-58.

VII. GROUPING OF CLAIMS

Claims 37, 38, 45, 46, 54, and 57 are grouped together.

Claims 39-44 and 47-52 are grouped together.

Claims 53, 55, 56, and 58 are grouped together.

VIII. ARGUMENTS

A. THE COMBINATION OF KUMASAKA ET AL (4799416) AND COTTON ET AL (4892022) DO NOT RENDER OBVIOUS THE INVENTION OF CLAIMS 37-58

The Examiner, in making this rejection, cites Kumasaka et al '416 for disclosing a fixed guard 4 and a movable guard 9. The Examiner acknowledges that Kumasaka et al '416 does not have an arbor cover. The Examiner cites Cotton et al '022 for disclosing a cover 6. However, Cotton et al '022 discloses a single movable guard or element 1, which substantially covers the blade and the entirety of which pivots about a pivot pin inserted through openings 14, 15 and boss 16, as best shown in Figure 5 (see col. 1,

lines 35-38). The cover 6 is mounted to the movable guard 1. Applicant asserts that the combination of Kumasaka et al '416 and Cotton et al '022 is improper.

In a decision of the C.A.F.C., Panduit Corp. v. Dennison Manufacturing Co., 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), Chief Judge Markey offered the opinion that hindsight reconstruction from isolated elements in a number of prior art references in order to arrive at the claimed combination is contrary to the purpose of the patent laws.

Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, Section 103.

810 F.2d at 1575, 1 USPQ2d at 1603.

The issues regarding the incorporation of an arbor cover on a guard assembly having both a fixed and a movable guard are not the same as those encountered when incorporating an arbor cover on a guard assembly with only a movable guard. In the movable guard 1 of Cotton et al '022, the opening 5 is provided to allow an operator access to a shaft of the saw blade because the movable guard 1 covers substantially all of the blade. The cover 6 closes the opening 5. However, there is no motivation in Cotton et al '022 to utilize a cover as disclosed for a guard assembly having both a fixed guard and a movable guard, as claimed. It is just this type of combining of references that the Court, in the Panduit decision, found to be impermissible.

In view of the above presented discussion, Applicants believe that the pending claims are patentably distinguishable over the art cited by the Examiner. Accordingly, Applicants respectfully request that this Board reverse the final rejection of claims 37-58.

With regard to claims 39, 42, 47 and 50, Applicant notes that these claims include the limitation of "said movable guard is disposed over said stationary guard." The Examiner acknowledges that Kumasaka et al '416 does not disclose the movable guard over the stationary guard. However, the Examiner takes Official Notice that this would have been an obvious modification. However, Applicants submit that absent a proper teaching, the modification of Kumasaka et al to make the movable guard 9 disposed over the fixed guard 4 is not obvious. Such a modification would require more than an obvious redesigning of the fixed guard 4, the pivot assembly for the movable guard 9 and the vacuum port of the fixed guard 4 of Kumasaka et al '416. Therefore, claims 39-44 and 47-52 should be allowable for these additional reasons.

It is noted that claims 53, 55, 56, and 58 each include the limitation of "a central axis of said torsional coil spring is offset from said arbor axis." The Examiner takes Official Notice that it is old and well known for coil springs to be offset. However, there is no proper teaching or suggestion for an offset coil spring as claimed or the benefit achieved with an offset coil spring. The radially offset configuration of the return spring allows the return spring to radially expand and contract to a greater degree in directions away from the saw's base assembly 12. This minimizes interference with the workpiece during cutting operations and thus maximizes the cutting depth capacity of the saw. Absent a proper teaching or suggestion of this feature, Applicant submits that this rejection is improper. Therefore, claims 53, 55, 56, and 58 should be allowable for these additional reasons.

Please charge Deposit Account No. 02-2548 in the amount of \$320, and well as any deficiency, or credit any overpayment pursuant to 37 C.F.R. § 1.16 or § 1.17.

Respectfully submitted,

Dated: March 13, 2002

Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, MI 48303
(248) 641-1600

By: Ryan W. Massey
Ryan W. Massey, Reg. No. 38,543
Attorney for Applicants

Enclosures: Three (3) copies of Appellant's Brief

APPENDIX

37. A cutting device for performing cutting operations on a workpiece, said cutting device comprising:

a base adapted to receive said workpiece;

a support attached to said base;

a drive assembly pivotable attached to said support, said drive assembly including a motor having an arbor shaft rotatably about an arbor axis;

a cutting tool attached to said arbor shaft;

a fixed guard fixedly attached to said drive assembly and pivotably with said drive assembly, said fixed guard covering a first portion of said cutting tool;

a movable guard pivotably attached to said drive assembly for pivotal movement about said arbor axis, said movable guard movable between a closed position covering a second portion of said cutting tool and an open position exposing said second portion of said cutting tool;

a separate arbor cover pivotably secured to said fixed guard, said arbor cover being pivotal between a first position covering said arbor shaft and a second position completely uncovering said arbor shaft; and

a torsional coil spring biasing said movable guard into said closed position.

38. The cutting device according to Claim 37, wherein said support is pivotably attached to said base.

39. The cutting device according to Claim 38, wherein said movable guard is disposed over said stationary guard.

40. The cutting device according to Claim 39, wherein said movable guard is movable between a closed position covering said second portion of said cutting tool and an open position uncovering a majority of said second portion of said cutting tool, said arbor cover being entirely uncovered when said moveable guard is in said closed and open positions.

41. The cutting device according to Claim 40, wherein said entire movable guard covers said fixed guard when said movable guard is in said open position.

42. The cutting device according to Claim 37, wherein said movable guard is disposed over said stationary guard.

43. The cutting device according to Claim 42, wherein said movable guard is movable between a closed position covering said second portion of said cutting tool and an open position uncovering a majority of said second portion of said cutting tool, said arbor cover being entirely uncovered when said movable guard is in said closed and open positions.

44. The cutting device according to Claim 43, wherein said entire movable guard covers said fixed guard when said movable guard is in said open position.

45. A cutting device for performing cutting operations on a workpiece, said cutting device comprising:

- a base adapted to receive said workpiece;
- a support arm attached to said base;
- a drive support slidably engaging said support arm;
- a drive assembly pivotally attached to said drive support, said drive assembly including a motor having an arbor shaft rotatably about an arbor axis;
- a cutting tool attached to said arbor shaft;
- a fixed guard fixedly attached to said drive assembly and pivotally with said drive assembly, said fixed guard covering a first portion of said cutting tool;
- a movable guard pivotally attached to said drive assembly for pivotal movement about said arbor axis, said movable guard movable between a closed position covering a second portion of said cutting tool and an open position exposing said second portion of said cutting tool;
- a separate arbor cover pivotally secured to said fixed guard, said arbor cover being pivotable between a first position covering said arbor shaft and a second position completely uncovering said arbor shaft; and
- a torsional coil spring biasing said movable guard into said closed position.

46. The cutting device according to Claim 45, wherein said support is pivotally attached to said base.

47. The cutting device according to Claim 46, wherein said movable guard is disposed over said stationary guard.

48. The cutting device according to Claim 47, wherein said movable guard is movable between a closed position covering said second portion of said cutting tool and an open position uncovering a majority of said second portion of said cutting tool, said arbor cover being entirely uncovered when said movable guard is in said closed and open positions.

49. The cutting device according to Claim 48, wherein said entire movable guard covers said fixed guard when said movable guard is in said open position.

50. The cutting device according to Claim 45, wherein said movable guard is disposed over said stationary guard.

51. The cutting device according to Claim 50, wherein said movable guard is movable between a closed position covering said second portion of said cutting tool and an open position uncovering a majority of said second portion of said cutting tool, said arbor cover being entirely uncovered when said movable guard is in said closed and open positions.

52. The cutting device according to Claim 51, wherein said entire movable guard covers said fixed guard when said movable guard is in said open position.

53. The cutting device described in Claim 37 wherein a central axis of said torsional coil spring is offset from said arbor axis.

54. The cutting device described in Claim 37 wherein said torsional coil spring is disposed within a blade cavity defined by said fixed and movable guards.

55. The cutting device described in Claim 54 wherein a central axis of said torsional coil spring is offset from said arbor axis.

56. The cutting device described in Claim 45 wherein a central axis of said torsional coil spring is offset from said arbor axis.

57. The cutting device described in Claim 45 wherein said torsional coil spring is disposed within a blade cavity defined by said fixed and movable guards.

58. The cutting device described in Claim 57 wherein a central axis of said torsional coil spring is offset from said arbor axis.

Please type a plus sign (+) inside this box → ☐



HDP/SB/21 based on PTO/SB/21 (08-00)

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/698,920
Filing Date	October 27, 2000
First Named Inventor	Meredith et al
Group Art Unit	3724
Examiner Name	K. Peterson
Attorney Docket Number	0275A-000168/DVB

Total Number of Pages in This Submission

ENCLOSURES (check all that apply)

☒ Fee Transmittal Form

☐ Fee Attached

☐ Amendment / Response

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/Incomplete Application

☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

☐ Assignment Papers (for an Application)

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a Provisional Application

☐ Power of Attorney, Revocation Change of Correspondence Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s) _____

☐ After Allowance Communication to Group

☐ Appeal Communication to Board of Appeals and Interferences

☒ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Other Enclosure(s) (please identify below):

return receipt postcard

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name

Harness, Dickey & Pierce, P.L.C.

Attorney Name
Ryan W. Massey

Reg. No.
38,543

Signature

Ryan W. Massey

Date

March 13, 2002

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below.

Typed or printed name

Ryan W. Massey

Signature

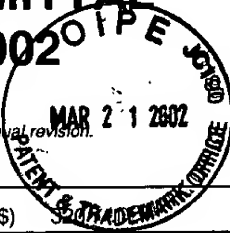
Ryan W. Massey

Date

March 13, 2002

**FEE TRANSMITTAL
for FY 2002**

Patent fees are subject to annual revision.

**Complete if Known**

Application Number	09/698,920
Filing Date	October 27, 2000
First Named Inventor	Meredith
Examiner Name	K. Peterson
Group / Art Unit	3724
Attorney Docket No.	0275A-000168/DVB

TOTAL AMOUNT OF PAYMENT (\$)**METHOD OF PAYMENT (check all that apply)**☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:

Deposit Account Number: 02-2548

Deposit Account Name: Black & Decker (U.S.) Inc.

The Commissioner is authorized to: (check all that apply)☐ Charge fee(s) indicated below ☐ Credit any overpayments
☒ Charge any additional fee(s) during the pendency of this application
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Fee Code	Entity (\$)	Small Fee Code	Entity (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1)

(\$) 0

2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
-20 **	0	X	0
Independent Claims	0	X	0
Multiple Dependent	X		0

Large Fee Code	Entity (\$)	Small Fee Code	Entity (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$) 0

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Fee Code	Entity (\$)	Small Fee Code	Entity (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet.	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	320.00
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17 (q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$) 320

SUBMITTED BY**Complete (if applicable)**

Name (Print/Type)	Ryan W. Massey	Registration No. Attorney/Agent)	38,543	Telephone	248-641-1600
-------------------	----------------	----------------------------------	--------	-----------	--------------

Signature

Date

March 13, 2002

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.